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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,307	04/10/2006	Jochen Ackerman	273100US0PCT	8081
22850	7590	04/24/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHO, JENNIFER Y	
			ART UNIT	PAPER NUMBER
			1621	
			NOTIFICATION DATE	DELIVERY MODE
			04/24/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/541,307	Applicant(s) ACKERMAN ET AL.	
	Examiner JENNIFER Y. CHO	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/15/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/08 has been entered.

Claims 1-22 are pending in this application.

Applicant's amendment filed 2/26/08 is sufficient to overcome the 102 rejection of the previous office action. Therefore, the rejection has been withdrawn.

Claim Rejections – 35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no evidence in the record for the amended claim language of "wherein dividing the bottom effluent from the vacuum

evaporation stage comprises selecting a proportion of the bottom effluent that will constitute the first portion based on current catalyst activity”, at the time of filing the application.

Additionally, the suggested amendment to claims raises an issue of new matter. Applicant refers to page 13, lines 8 to 13 of the specification and to original claims 1-3, however, the only contemplation of current catalyst activity is to the reaction apparatus, not the vacuum evaporation stage or a film evaporator. In addition the current catalyst activity in the specification refers to the entire stream, not to a portion of the stream. This amounts to a new concept that was not present at time of filing.

Claims 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no evidence in the record for the claim language of “wherein the first portion is recycled directly to the reaction apparatus” and “wherein the third portion is recycled directly to the reaction apparatus”, at the time of filing the application.

Additionally, the suggested new claims raise an issue of new matter. Applicant refers to Figures 2-4, however, the Examiner is not convinced that the figures demonstrate this portioning and direct recycling to the reaction apparatus. Nor is there a convincing description of the figures within Applicant's specification which would

support these new claims. This amounts to a new concept that was not present at time of filing.

Claims 1-3 and 7-15, along with newly added claims 20-22, remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no evidence in the record for the amended claim language of “first portion, second portion, third portion and fourth portion”, at the time of filing the application.

Response to Arguments

Applicant's arguments have been considered but are not persuasive for the following reasons:

The Examiner acknowledges Applicant's argument that though the terms do not literally appear in the present specification, the terms present description with greater clarity.

The Examiner asserts that it is still unclear in the present specification and figures how these “portions” are divided. The Applicant points to Figures 2-4, however, after careful examination, the Examiner is still not convinced that the Applicant has shown a portioning of the streams and what would determine the portioning of the streams.

Claim Rejections – 35 USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in regards to the “current catalyst activity”. It is unclear what defines this current catalyst activity. Does the first portion increase the current catalyst activity or decrease it? Is the first portion selected and divided based on an active or inactive catalyst? Clarification is requested.

Claims 1-19, along with newly added claims 20-22, remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite in regards to the second portion and the fourth portion of the bottom effluent. The claims do not set forth any steps for the second and fourth portion that are involved in the process, and it is unclear in the claim language what the applicant is intending to encompass by dividing the bottom effluent into several portions. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced

Response to Arguments

Applicant’s arguments have been considered but are not persuasive for the following reasons:

The Examiner acknowledges Applicant’s argument that though the terms need not be limited and that they are merely broad, not unclear.

The Examiner asserts that it is still unclear in the claim language what constitutes the portioning. The terms are vague and it is unclear what would determine the components of each of the stream portions.

Claim Rejections – 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19, along with newly added claims 20-22, remain rejected under 35 U.S.C. 103(a) as being unpatentable over Geisendoerfer et al. (US Patent Publication 2004/0171868 A1). For reasons, see previous office action and responses stated herein.

Response to Arguments

Applicant's arguments have been considered but are not persuasive for the following reasons:

The Examiner acknowledges Applicant's argument that Geisendoerfer et al. does not teach a process in which a portion of a bottom effluent from a film evaporator and/or a vacuum evaporation stage is recycled to a reaction apparatus based on current catalyst activity.

However, the Examiner asserts that Geisendoerfer et al. does teach a process in which a portion of a bottom effluent from a film evaporator and/or a vacuum evaporation stage is recycled to a reaction apparatus based on current catalyst activity.

Geisendoerfer et al. teaches catalyst removal is effected by subjection to a thin-film or flash evaporation (page 8, section 166 and 167) in which the bottom product which contains the catalyst (page 8, section 169) is partly recycled back into the reaction apparatus (page 8, section 170). In addition, Geisendoerfer et al. teaches that there are advantages to interchanging and combining these steps based on exposure to the catalyst and so that catalyst-induced secondary or subsequent reactions are reduced (page 8, section 172 and 173). Thus, Geisendoerfer et al. envisions a link to the process steps and catalyst activity.

The Examiner acknowledges Applicant's argument that Geisendoerfer et al. does not teach a process, in which an intermediate work-up process is not required, for the recycled portions of a bottom effluent being recycled to the reaction apparatus.

However, the Examiner asserts that Geisendoerfer et al. does teach that a portion of the bottom mixture is partly recycled directly to the transesterification reaction apparatus (page 8, section 170). In addition, the art teaches that there are advantages to interchanging, combining and giving preference to certain steps (page 8, section 171 and 173).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Y. Cho whose telephone number is (571) 272 6246. The examiner can normally be reached on 9 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Cho
Patent Examiner
Art Unit: 1621

/Jafar Parsa/
Primary Examiner, Art Unit 1621
April 21, 2008